

DETAILED ACTION

1. Amendment and response filed by applicants date Jan. 16, 2012 have been entered and considered carefully.

Claims 2-3, 6-11, 13-14, 22, 26-27 have been canceled. Claims 1, 4-5, 12, 15-21, 23-25 and 28-33 and newly added 34 are pending.

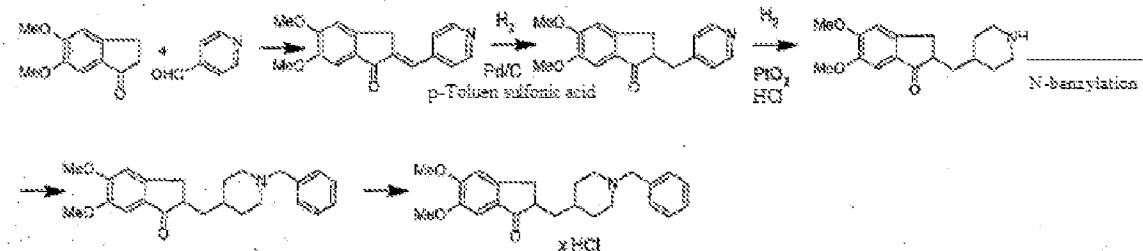
2. Applicants have provided affidavit with translation of the priority documents and the priority date has been verified to be Nov. 5, 2003.

3. The rejection of claim 1 under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential element, is dropped in view of the incorporation of the reaction conditions in the claims.

4. The rejection of claims 1-6, 12, 15-20, 22-28, 31 (now 1, 4-5, 12, 15-20, 23-25, 28, 31) under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement is dropped in view of the incorporation of specifics for the Markush elements.

5. The rejection of claims 1-6, 15-28, 30-33 (now 1, 4-5, 12, 15-20, 23-25, 28-33) under 35 U.S.C. 102(e) as being anticipated by Kumar et al. WO 04/082685 is maintained for reason of record. It was delineated that:

Kumar et al. disclosed the process (see combination of preparation 1, examples 1-3)



Please note the limitation of approximate stoichiometric amount of –toluene sulfonic acid and 5,6-dimethoxyindanone in preparation 1 and the conditions of all the steps including the amended catalysts which are within the scope and ranges of the claims. The claims are drawn to

both stepwise or continuous and no limitation that the catalysts and acid in the stepwise manner has to be the same as the continuous manner.

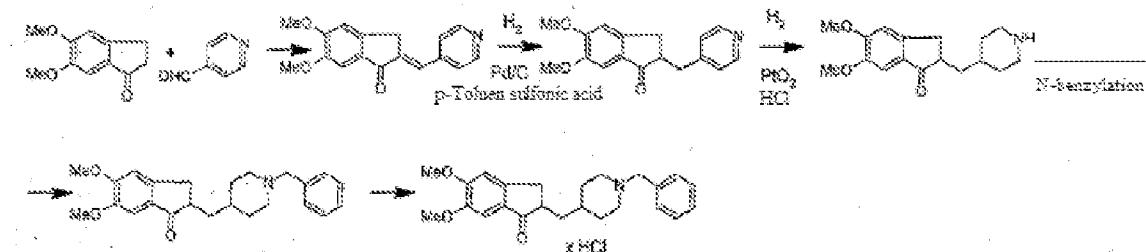
Applicants provided translation of the priority documents and verified that the claims are reduced to practice by the priority date which is Nov. 5, 2003. The priority documents for WO2004/082685 is hereby provided for applicants convenience. Please note that the '685 patent is in English, the priority document is in English and the '685 designate US as a designated state, therefore, is a 102(e) reference entitled to the *effective* filing date of Mar. 21, 2003 which is before the instant priority date.

The 131 affidavit stated that the work was made in China after Jan. 1, 1996 and reduced to practice by Nov. 5, 2003 which is after the priority date of the '685 102(e) date.

6. The rejection of claims 1-6, 12, 15-33 (now 1, 4-5, 12, 15-20, 23-25, 28-34) under 35 U.S.C. 103(a) as being unpatentable over Kumar et al. WO04/082685 (102e date 3/2003) in view of Lensky US 5,606,064 is maintained. It was delineated that:

Determination of the scope and content of the prior art (MPEP §2141.01)

Kumar disclosed the process as following:

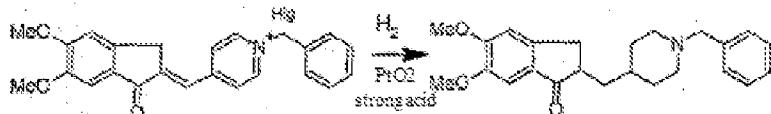


See preparation 1, exam[le 1, and 2.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between the prior art and the instant claims is that instead of using PtO₂ in reduction of both the double bond and the pyridinyl ring (see step b being both stepwise and continuous), the reduction was in a stepwise manner with the double bond using PdC and the pyridinyl ring using PtO₂.

Lensky '064 taught the process of making the claimed product:



wherein the double bond

and the pyridinyl ring was reduced continuously and PtO₂/strong acid was operable for both the double bond and the pyridinyl ring.

Finding of prima facie obviousness---rational and motivation (MPEP § 2142-2143)

One having ordinary skill in the art in possession of the above references is in possession of the claimed process since employing a stepwise process continuously is prima facie obvious (Cohn v. Comm 148 USPQ 486). Especially, the operation of the Kumar steps in a continuous manner with alternative known catalyst is prima facie obvious and the operable conditions using the same PtO₂ catalyst have been well delineated and guided by the analogous art.

Kumar exemplified more limited conditions, it is prima facie obvious to extend the operable conditions such as solvents, temperature, inert substituents etc. to the generic teaching of the reference as well as those in analogous art since such optimization is an effect oriented manipulation of the chemical process. In re Boesch 205 USPQ 215.

The declaration filed by applicants stated that the overall yielding of Lensky '062 is inferior has no relevancy for the instant rejection because no comparison between reduction by PdC and PtO₂ was made which is the basis of establishing prima facie case. The claims incorporated all catalysts containing Pt, Pd, Ni, Ru salts or oxides thus included the prior art catalyst of Pd salt. The more limited conditions of temperature and pressure are considered effect oriented optimization routine for chemical process.

7. The rejection of claims 1-2, 4-6, 12, 15-33 (now 1, 4-5, 12, 15-20, 23-25, 28-34) under 35 U.S.C. 103(a) as being unpatentable over Lensky US 5,606,064 in view of WO97/22584 is dropped in view of the declaration stating that by changing sequence of operating steps, the yield increased from 58% to 85% which is 27%. This increase considered by artisan in the chemical field to be unexpected (see 132 p. 3-4)

8. The rejection of claims 1-6, 12, 15-33 (now 1, 4-5, 12, 15-20, 23-25, 28-34) under 35 U.S.C. 103(a) over Lensky US 5,606,064 in view of WO 97/22584 further in view of Devries et al. US 5,916,902 is dropped because the rejection by the primary references have been obviated see supra.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CELIA CHANG, Ph. D. whose telephone number is 571-272-0679. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet L. Andres, Ph. D., can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OACS/Chang
Feb. 8, 2012

*/Celia Chang/
Primary Examiner
Art Unit 1625*